

RCE & AMENDMENT
Serial No. 10/612,079
Docket No. ORW01-GN003

REMARKS

Introductory Comments

Claims 41-46, 48-76, and 105 are pending in the present application. Claims 41, 57, and 63 have been amended. Claims 1-40 and 47 have been cancelled.

A Request for Continued Examination has been concurrently filed with the instant Amendment.

Reconsideration of the application is respectfully requested.

Instant Office Action – 35 U.S.C. § 102 Rejections

Claims 1-14, 17, 20, 41-54, 57, and 60 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,592,622 to Ferguson (“Ferguson”). This ground of rejection is now moot as to claims 1-14, 17, 20, but has been fully overcome with respect to claims 41-54, 57, and 60 by the amendments to claim 41.

Claim 41 has been amended to recite in part, a lining mounted to at least one of the tibial component and the femoral component in the prosthetic knee joint, and remote from native connective tissue, so that the lining is between the tibial component and the femoral component approximate a prosthetic intercondylar channel of the femoral component to supplement periarticular stability between the tibial component and the femoral component. In other words, the lining is not mounted to native connective tissue. Clearly, Ferguson does not disclose or suggest such a lining.

In the June 5 Office action, the Examiner asserts that the “band assembly” of Ferguson “is capable of being mounted to at least one of a tibial component 10 so that the lining is between the tibial component and a femoral component and approximate a prosthetic intercondylar channel.”¹ But the Examiner’s assertion by itself proves that Ferguson does not anticipate Applicant’s claims 41-54, 57, and 60.^{2,3} Instead, the

¹ June 5, 2007 Office action, p. 2.

² See M.P.E.P. § 2131 “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

³ See M.P.E.P. § 2131 “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

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Examiner is really relying on obviousness to assert that the structure of Ferguson somehow inhibits allowance of Applicant's claims. Even taking this obviousness argument into account, Applicant's claims 41-54, 57, and 60 are in condition for allowance.

The mere fact that Ferguson could be modified does not render obvious Applicant's claims unless Ferguson also suggests the desirability of the combination.⁴ Although it may be alleged that Ferguson is capable of being modified as recited in Applicant's claims, one skilled in the art must be motivated to do so. But those skilled in the art would not have been motivated to modify Ferguson as recited in Applicant's claims. If anything, Ferguson teaches away from Applicant's claims.

Those portions of Ferguson cited to by the Examiner teach a structure entirely at odds with the structure claimed by Applicant. Ferguson teaches using a resorbable material connected to a patient's native connective tissue to spur on native connective tissue growth that connects bone to the tibial prosthetic component.⁵ But Applicant is not at all interested in forming connective tissue that couples soft tissue to a prosthetic component. If anything, Applicant's lining avoids the formation of coupling soft tissue to prosthetic components. Ferguson, on the other hand, is directed to the exact opposite situation and teaches those skilled in the art of a preference for using resorbable materials to form bridges mounted to native tissue that eventually transform into connective tissue coupling this soft tissue to prosthetic components.⁶ In this regard, Ferguson clearly teaches away from Applicant's claims, which recite a lining remote from connective tissue. If the Examiner disagrees, Applicant respectfully requests the Examiner point to the disclosure of Ferguson stating that the resorbable lining not mounted to native connective tissue.

⁴ See M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

⁵ See U.S. Patent No. 6,592,622 at column 5, lines 1-59.

⁶ See U.S. Patent No. 6,592,622 at column 1, lines 7-9, TECHNICAL FIELD OF THE INVENTION section, "The present invention relates generally to a prosthesis, and more particularly to an apparatus and method for securing soft tissue to an artificial prosthesis."

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35 U.S.C. § 103 Rejections

Claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61, and 62 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson") in view of U.S. Patent No. 6,616,698 to Scarborough ("Scarborough"). This ground of rejection is moot as to claims 15, 16, 18, 19, 21, 22, 33-40, and has been fully overcome for claims 55, 56, 58, 59, 61, and 62 by the amendments to claim 41.

As discussed previously, claim 41 has been amended to recite in part, a lining mounted to at least one of the tibial component and the femoral component in the prosthetic knee joint, and remote from native connective tissue, so that the lining is between the tibial component and the femoral component approximate a prosthetic intercondylar channel of the femoral component to supplement periaricular stability between the tibial component and the femoral component. In other words, the lining is not mounted to native connective tissue. Ferguson does not disclose or suggest Applicant's claimed lining, nor using a reabsorbable material in any form other than to form soft connective tissue. Moreover, Ferguson does not disclose or suggest using a reabsorbable lining remote from connective tissue.

In the June 5 Office action, the Examiner incorrectly asserts that Ferguson discloses all of the limitations of claims 55, 56, 58, 59, 61, and 62, but for "an antibiotic agent such as gentamicin, a clotting factor and osteogenic materials such as stem cells and transforming growth factor."⁷ As discussed previously, Ferguson does *not* disclose all the limitations of old claim 41 or claim 41 as amended. Thus, the Examiner must have been relying on obviousness to assert that the structure of Ferguson somehow inhibits allowance of Applicant's claims. But the Examiner's obviousness argument is not well founded.

The mere fact that Ferguson could be modified does not render obvious Applicant's claims unless Ferguson also suggests the desirability of the combination.⁸ Although it may be alleged that Ferguson is capable of being modified as recited in

⁷ June 5, 2007 Office action, p. 3.

⁸ See M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

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Applicant's claims, one skilled in the art must be motivated to do so. But those skilled in the art would not have been motivated to modify Ferguson. If anything, Ferguson teaches away from Applicant's claims.

Those portions of Ferguson cited to by the Examiner teach a structure entirely at odds with the structure claimed by Applicant. Ferguson teaches using a resorbable material connected to a patient's native connective tissue to spur on native connective tissue growth that connects bone to the tibial prosthetic component.⁹ But Applicant is not at all interested in forming connective tissue that couples soft tissue to a prosthetic component. If anything, Applicant wants to avoid coupling soft tissue between joints to prosthetic components. Ferguson, on the other hand, is directed to the exact opposite situation and teaches those skilled in the art of a preference for using resorbable materials to form bridges that are mounted to connective tissue and transform into soft tissue connecting to certain prosthetic components.¹⁰ In this regard, Ferguson, if anything, clearly teaches away from Applicant's claims. If the Examiner disagrees, Applicant respectfully requests the Examiner point to the disclosure of Ferguson stating that the resorbable lining not mounted to native connective tissue.

Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections of record over Ferguson in combination with Scarborough for claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61, and 62 are respectfully requested.

Claims 23-25 and 27-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson"). This ground of rejection is now moot in view of the cancellation of these claims.

Withdrawal of the 35 U.S.C. § 103(a) rejection of record over Ferguson for claims 23-25 and 27-32 are respectfully requested.

⁹ See U.S. Patent No. 6,592,622 at column 5, lines 1-59.

¹⁰ See U.S. Patent No. 6,592,622 at column 1, lines 7-9, TECHNICAL FIELD OF THE INVENTION section, "The present invention relates generally to a prosthesis, and more particularly to an apparatus and method for securing soft tissue to an artificial prosthesis."

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Claim 26 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson") in view of U.S. Patent No. 6,461,320 to Yencho et al ("Yencho"). This ground of rejection is now moot in view of the cancellation of this claim.

Withdrawal of the 35 U.S.C. § 103(a) rejection of record over Ferguson for claim 26 is respectfully requested.

Claims 63, 65-76 and 105 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent Reissue No. 29,757 to Helfet ("Helfet") in view of U.S. Patent No. 5,759,205 to Valentini ("Valentini"). This ground of rejection has been fully overcome by the amendments to claim 63 and is traversed with respect to claim 105.

Claim 63 has been amended to recite, at least in part, a lining mounted to at least one of the stabilizing post and an inner surface of the femoral component at least partially defining the prosthetic intercondylar channel, and remote from native connective tissue, to, at least temporarily, supplement periarticular stability between the stabilizing post and the prosthetic intercondylar channel, the lining comprising a biologically reabsorbable lining material. Neither Helfet, nor Valentini, disclose a biologically reabsorbable lining material mounted to at least one of the stabilizing post and an inner surface of the femoral component at least partially defining the prosthetic intercondylar channel, which is remote from native connective tissue. For this reason alone, claim 63 is in condition for allowance. Likewise claims 65-76 depending from claim 63 are also in condition for allowance, as Helfet and Valentini fail to disclose all of the claimed limitations of these claims. Similarly, claim 105 includes limitations not taught or suggested by Helfet or Valentini.

Second, the prior art method of operation of Valentini contradicts the alleged suggestion or motivation to modify Helfet. M.P.E.P. § 2143.02 provides in relevant part:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (C.C.P.A. 1959).

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The Office action alleges on page 4 that the motivation to combine Valentini with Helfet is:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a coating or lining of biodegradable material in the Helfet prosthesis, as taught by Valentini, *to promote implant incorporation into a patient's body.*

But the *intended use* of the coating or lining of Valentini is to *permanently bond*, in a fixed position, the prosthetic device to native tissue (such as bone). This is anything *but* the intended use of Applicant's invention or of any repositionable joint.

It is simply illogical to assert that those skilled in the art would want to coat a prosthetic joint with a compound known to inhibit movement by bonding the prosthetic joint to the native tissue by using the coating of Valentini. One of the intended uses of any prosthetic joint is mobility, which is clearly at odds with the disclosure of Valentini, and is why one skilled in the art would not look to the coatings of Valentini to achieve this goal. If anything, those skilled in the art would avoid using the coatings of Valentini.

If a proposed modification would render the prior art invention unsatisfactory for

its intended purpose, then there is no suggestion or motivation to make the proposed
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